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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Leonel Yanez MARTINEZ et al.	**MAIL STOP: OFFICE OF PETITIONS**
Serial No. 10/613,433	Group Art Unit: 2831
Filed: JULY 3, 2003	Examiner: William Mayo II
Title:**DRY WATER RESISTANT COAXIAL CABLE AND METHOD OF MANUFACTURE THEREOF**	
Docket No. MX/JFServ-001	

PETITION TO WITHDRAW OBJECTION TO CLAIMS AND NEWLY CITED PRIOR ART

This is a petition to withdraw the objection to claims 71-72, and 74-75 in the above-identified application. In addition, Applicants are petitioning newly cited art, Hughey, US 5,043,538 in the Final Rejection dated May 19, 2009 and another cited prior art, Midner, US 3,795,640 in the Examiner Answer dated February 18, 2010.

BACKGROUND

The Examiner indicated that Claims 71-72 and 74-75 were objected to because they render the claims "**indefinite**" in the Final Rejection dated May 19, 2009, item 3 on page 2. The Applicants filed an Appeal dated November 24, 2009 and argued that the claims are "**definite**." The Examiner Answer dated February 18, 2010 indicated that Claims 71-72 and 74-75 were

objected to and were **not** rejected under 35 U.S.C. 112, although he stated that they render the claims **indefinite and should not be appealable, rather they are petitionable**.

Moreover, the Examiner cited a new prior art, Hughey, US 5,043,538 in the Final Rejection dated May 19, 2009 on page 14.

Again, the Examiner cited a new prior art, Midner, US 3,795,640 in the Examiner Answer on pages 26-27.

DISCUSSION

A. Objections to Claims 71-72 and 74-75

Applicants respectfully petition the Commissioner to withdraw the objection of Claims 71-72 and 74-75.

It is submitted that the "second polyethylene film" in Claim 71 is definite. In this regard, Claim 68 recited that the second polyethylene film as the reinforcement layer with same characteristics as the 1st layer. The Applicants' specification provided that "the diameter of the third layer is similar to 1st layer with a 13.0±0.10 mm dia." See page 4, lines 14-16; page 6, lines 17-25; page 13, lines 15-24.

It is submitted that the "external conductor" in Claim 72 is definite. In this regard, Claim 72 recited the external conductor is formed by tape made of an aluminum or copper alloy or combined with other elements." The Applicants' specification provided that "the external conductor has a thickness of 0.34 mm and 13.7±0.1 mm dia." See page 4, lines 17-20; page 6, line 25 to page 7, lines 1-8; page 14, lines 3-5.

It is submitted that the "moisture protection elements" in Claim 74 is definite. In this regard, Claim 74 recited the "moisture protection elements" have an absorption speed of > 15 ml/g per minute and their absorption capacity is over 30 ml/g. The specification provided that the water penetration protective element has an absorption speed is > 15 ml/g per minute and the absorption capacity is over 30 ml/g. Moreover, the Applicants' specification provided that the water penetration protective element 16 is applied helically, annularly or longitudinally. See page 4, lines 22-24; page 7, lines 8-15; and page 14, lines 5-9.

It is submitted that the "external cover" in Claim 75 is definite. In this regard, Claim 75 recited the protective cover is based on low, medium, high density polyethylene or a combination thereof. The Applicants' specification provided that the cover is 15.5 mm ±0.10 mm with 0.67 mm ±0.02 mm thickness. See page 4, lines 25 to page 5, lines 1-3; page 7, lines 16-25; and page 14, lines 17-18.

Applicants submit that claim indefiniteness is analyzed *"not in a vacuum,* but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by a person possessing the ordinary level of skill in the pertinent art (POSA);" the failure **to provide explicit antecedent basis for a term does not always render** the claim **indefinite.** *Energizer Holdings, Inc.* v. *TTC, 11* USPQ 2d 1625 (Fed. Cir.2006) quoting *In reMoore,* 169 USPQ 236 (CCPA 1971). A claim containing terms which are seemingly vague is not indefinite if it is **precise when read in the context of the specification.** *Charvat v. Comnr. Pats.*, 182 USPQ 577 (1974).

Applicants submit that the Examiner has not established a *prima facie* case of indefiniteness under 35 U.S.C. 112 because there is literal support in the specification for the claims. The burden is on the Patent Office to establish *prima facie* case that the indefiniteness requirement has not been met. The Examiner has the initial burden of presenting reasons or evidence supporting his position that the skilled artisan would not recognize the claimed invention in the specification. *Ex parte Sorensen,* 3 USPQ 2nd 1462, 1463 (BPAI 1987) citing *In re Wertheim,* 541 F.2d 257 (CCPA 1976)

From the above, in light of the disclosure of the terms in the specification and claims, it is submitted that the limitations are definite. Applicants request that the Examiner's objections be withdrawn.

B. Newly Cited Prior art

Applicants request that that the newly cited prior art be withdrawn.

MPEP§706.07 (a) Improper Final Rejection provides as follows:

"...A second or subsequent action on the merits in any application or patent involved in reexamination proceedings should **not be made final if it includes a rejection, on prior art not of record,** of any claim amended to include limitations which should reasonably have been expected to be claims. See MPEP §904 et seq.

In the present application, the Examiner cited a new prior art, Hughey, US 5,043,538 in the Final Rejection dated May 19, 2009 on page 14.

The Examiner should not have made the Office Action Final because a new prior art was cited. The Applicants should been given notice regarding this new prior art. In addition, the Examiner cited a new prior art, Midner US 3,795,640 in the Examiner Answer on pages 26-27.

Applicants compare the present situation to a contract. In order for a contract to be *enforceable*, there should be an offer (a notice by one party to the other), an acceptance (notice that the other has received offer) and consideration (fee or fairness that sufficient notice was provided for the other party's benefit). In this situation, there are newly cited prior art without advance notice to the Applicant. In a situation where it is time sensitive such as responses to Office Action, there should at least be enough *notice* regarding a newly cited prior art such that there is *no element of surprise*. Even if the other party accepted the offer, there won't be a contract because there was **no** consideration to the other party regarding sufficient notice that a newly cited prior art would be used in rejecting the claims. It is submitted that there is no fairness to the other party if there is no sufficient notice. It is submitted that the Examiner should not be citing new prior art when the prosecution has already been closed.

Moreover, it is submitted that the first search of the Examiner should be such that the Examiner need **not** make a second search of prior art unless necessitated by an amendment. The Examiner should have had conducted a complete and thorough search of the prior art. See MPEP §904. In this case, Applicants **did not amend** the claims. However, the Examiner cited two new prior art in rejecting the claims of the present application.

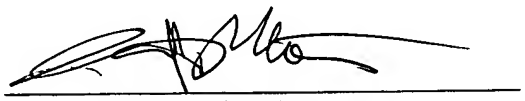
From the above, it is submitted that The Examiner should not have rejected the present application on two newly cited prior art. The two newly cited prior art which are not of record should have been withdrawn.

CONCLUSION

In conclusion, Applicants respectfully request that the withdrawal of objection of Claims 71-72 and 74-75, as well as, withdrawal of newly cited prior art for the reasons set forth above, be granted.

In the event that there are any problems which can be expedited by telephone conference, the Examiner is invited to telephone the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,
LAW OFFICE OF CARMEN PILI EKSTROM

By: 
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